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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/020,933	12/19/2001	Noriyuki Kawano	217311US2	9893
22850	7590	08/11/2005	EXAMINER	
OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314			ORTIZ CRIADO, JORGE L	
			ART UNIT	PAPER NUMBER
			2655	

DATE MAILED: 08/11/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/020,933	Applicant(s) KAWANO, NORIYUKI	
	Examiner Jorge L. Ortiz-Criado	Art Unit 2655	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 June 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-57 is/are pending in the application.
- 4a) Of the above claim(s) See Continuation Sheet is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,8,12,13,19,21,23-25,30,32-34,38,40-42,47,49-51,55 and 57 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 19 December 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>20050728</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

1. Applicant's election with traverse of Species XI Fig. 21 claims 1,2,8,12,13,19,21,23-25,28,30,32-34,38,40-42,47,49-51,55 and 57 is acknowledged.

Claims 3-7,9-11,14-18,22,26,27, 29,31,35-37,39,43-46,48,52-54 and 56. withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected species, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on 06/20/2005.

Furthermore, claim 28 is withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected Species VI Fig. 14-15, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on 06/20/2005.

The traversal is on the ground(s) that:

(a) The outstanding Office Action merely does not establish the appropriate explanation statement in that the application contains claims directed to the patentably distinct species.

This is not found persuasive because as provided in MPEP § 809.02 (a) reproduced below:

"Clearly identify each (or in aggravated cases at least exemplary ones) of the disclosed species, to which claims are restricted. The species are preferably identified as the species of figures 1, 2, and 3 or the species of examples I, II,

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and III, respectively. In the absence of distinct figures or examples to identify the several species, the mechanical means, the particular material, or other distinguishing characteristic of the species should be stated for each species identified. If the species cannot be conveniently identified, the claims may be grouped in accordance with the species to which they are restricted."

The Examiner clearly identifies in the Office Action the distinct species of the claimed the invention and supporting such finding by providing figures that clearly identify the distinct species of the invention the species were conveniently identified with the figures.

(b) No explanation, or separate status in the art, or a different field of search.

This is not found persuasive because as provided in MPEP § 808.01 Species:

-- Where there is no disclosure of relationship between species (see MPEP § 806.04(b)), they are independent inventions and election of one invention following a requirement for restriction is mandatory even though applicant disagrees with the examiner.

There must be a patentable difference between the species as claimed. See MPEP § 806.04(h). Since the claims are directed to independent inventions, restriction is proper pursuant to 35 U.S.C. 121, and it is not necessary to show a separate status in the art or separate classification. A single disclosed species must be elected as a prerequisite to applying the provisions of 7 CFR 1.141 to additional species if a generic claim is allowed. --

Accordingly, it is not required to show a separate status in the art or separate classification.

The requirement is still deemed proper and is therefore made FINAL.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 1,2,8,12,13,19,21,23-25,30,32-34,38,40-42,47,49-51,55 and 57 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

The examiner cannot ascertain/map where in the specification including the detailed description and drawings support is found as to make and/or use “a magnet magnetized in at least three polarities” and “magnetized in four polarities”. The only polarities found shown in the drawings are the N (north) and S (south), but no description is found on a “third” or “fourth” polarity. Applicant’s cooperation is respectfully requested, as to explain where in the specification support is found, in regard of how to obtain a magnet with a “third/fourth” polarity other than the N and S polarities.

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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5. Claims 24, 25, 30, 32, 33, 34, 38, 40, 41, 42, 47, 49, 50, 51, 55 and 57 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 24, 33, 41 and 55 recites the limitation "the inclination" in the first line of the claim. There is insufficient antecedent basis for this limitation in the claim.

Claim 24, 33, 41 and 55 recites the limitation "the sum of drive forces" in lines 9 and 10 of the claims. There is insufficient antecedent basis for this limitation in the claim.

Claim 24, 33, 41 and 55 recites the limitation "the center of gravity" in line 11 and 12 of the claims. There is insufficient antecedent basis for this limitation in the claim.

Claim 24, 33, 41 and 55 recites the limitation "the difference" in line 11 and 12 of the claims. There is insufficient antecedent basis for this limitation in the claim.

Claims 32 and 49 recites the limitation "the printed circuit board" in line 3 of the claim. There is insufficient antecedent basis for this limitation in the claim.

Claims 32, 40, 49 and 57 recites the limitation "a plurality of a printed circuit board(s) and further recites "... coils mounted on the printed circuit board". It is unclear in which of the

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plurality of the plurality of board(s) the coils are mounted, making the claim language ambiguous and indefinite.

Claim Objections

6. Claim 30, 47 and 55 are objected to because of the following informalities:

In the second line of the claims “a plurality of the magnet” should be “a plurality of magnets”.

Appropriate correction is required.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 1,2,8,12,13,19,21,23-25,30,32-34,38,40-42,47,49-51,55 and 57 are rejected under 35 U.S.C. 102(b) as being anticipated by Ikegame (Japanese Pat. No. JP10-116431).

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Regarding claims 1 and 12, Ikegame discloses an objective lens drive apparatus for use in an optical pickup (See Abstract), comprising:

a/two magnetic circuit(s) including a magnet magnetized in at least “three polarities” (See Detailed description [0033]; Figs. 11, 12, ref# 8,9); and

a coil unit including a focus coil (See detailed description [0028]; Figs. 12, ref # 3),

a tracking coil (See detailed description [0028]; Figs. 12, ref # 4)

and a tilt coil (See detailed description [0028]; Figs. 12, ref # 5,6),

wherein the focus coil, the tracking coil and the tilt coil are disposed within a magnetic gap of (one of) the magnetic circuit(s) (See detailed description [0028]; Figs. 11,12)

Regarding claims 2, 13, 25, 34, 42 and 51 Ikegame discloses wherein the magnet is magnetized in four polarities (see Figs 11 and 12, ref #8,9).

Regarding claims 8,19, 30, 38, 47 and 55, Ikegame discloses wherein “the/one of” magnetic circuit includes a plurality of magnets, and the coil unit is disposed within the magnetic gap formed by the magnets (see Figs 11 and 12)

Regarding claim 21, Ikegame discloses wherein the coil unit includes a plurality of first printed circuit boards and second printed boards, and the focus coil and the tracking coil are mounted on the first printed circuit board and the tilt coil is mounted on the second printed board (See Detailed description [0028]; Figs. 11, 12,ref# 23,24)

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Regarding claim 23, Ikegame discloses wherein the coil unit is fixed to the two side surfaces of a lens holder extending in parallel with a tracking direction (See Detailed description [0028]; Figs. 11, 12)

Regarding claims 24, 33, 41 and 50 Ikegame discloses an objective lens drive apparatus for use in an optical pickup for detecting the inclination of an optical disk to adjust the inclination of an objective lens in accordance with an inclination signal of the optical disk (See Abstract), comprising:

a/two magnetic circuit(s) including a magnet magnetized in at least “three polarities” (See Detailed description [0033]; Figs. 11, 12, ref# 8,9); and

a coil unit including a focus coil (See detailed description [0028]; Figs. 12, ref # 3),

a tracking coil (See detailed description [0028]; Figs. 12, ref # 4)

and a tilt coil (See detailed description [0028]; Figs. 12, ref # 5,6),

wherein the focus coil, the tracking coil and the tilt coil are disposed within a magnetic gap of (one of) the magnetic circuit(s) (See detailed description [0028]; Figs. 11,12)

wherein a focus/tracking servo is executed by supplying currents respectively to a plurality of the focus/tracking coils due to the sum of drive forces generated in the plurality of focus coils, wherein the inclination adjustment of the objective lens is executed by generating moment around the center of gravity of a movable part due to the difference between the drive forces (see detailed description [0031]-[0038]; Figs. 13-15)

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Regarding claims 32, 40, 49 and 57, Ikegame discloses wherein the coil unit includes a plurality of a printed circuit board, and the focus coil and the tracking coil are mounted on the printed circuit board (See Detailed description [0028]; Figs. 11, 12, ref# 23,24)

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jorge L. Ortiz-Criado whose telephone number is (571) 272-7624. The examiner can normally be reached on Mon.-Thu.(8:30 am - 6:00 pm),Alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wayne R. Young can be reached on (571) 272-7582. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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W. R. YOUNG
PRIMARY EXAMINER